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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,514	10/25/2001	Rebecca Ann Frana-Guthrie	0212-0001	1677

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BEEM PATENT LAW FIRM  
53 W. JACKSON BLVD., SUITE 1352  
CHICAGO, IL 60604-3787

EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 03/30/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,514

Applicant(s)

Frana-Guthrie et al.

Examiner

Ljiljana V. Ciric *AVC*

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 25, 2003 and Dec 11, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-11, and 13 is/are rejected.
- 7) ☒ Claim(s) 5, 8, and 12 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 25, 2003 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on December 11, 2003 and November 25, 2003 have been entered.

2. Claims 1 through 13 remain in the application, all as amended, either directly or indirectly.

### *Response to Arguments*

3. Applicant's arguments, see Paper No. 14, filed on November 25, 2003, with respect to the rejection(s) of the claims under 35 U.S.C. 112, first and second paragraphs, have been fully considered and are persuasive, particularly in view of the corresponding amendments to the claims, the drawings, and the specification. Therefore, the aforementioned rejection has been withdrawn.

Applicant's arguments filed on November 25, 2003 have been fully considered but they are not persuasive with regard to the applicability of the Struss et al. reference as cited in the previous Office action nor with regard to the applicability of the Williams reference as also cited in the previous Office action.

In general, applicant's arguments are based on an overly narrow interpretation of the claims. As previously noted, claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

In response to applicant's argument that the Struss et al. and the Williams ('727) references fail to disclose a cooling package for an agricultural combine, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior-art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Also, the arguments with regard to the Williams as cited in the previous Office action are moot in that the rejection of claims 1, 9, and 10 as amended is under a different statute and thus constitutes a different rejection.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

#### ***Drawings***

4. The replacement drawings were received on November 25, 2003 and the copies thereof received on November 28, 2003. These drawings are approved, pending correction of the informalities noted on the attached Notice of Draftsperson's Patent Drawing Review, PTO-948 and pending proper labeling of the replacement drawings as "Replacement Drawings" as now required by the revised version of 37 CFR 1.121(c) effective July 30, 2003.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 2 through 4, 6, 7, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Struss et al.

*Struss et al.* discloses a cooling package essentially as claimed, including: a fan shroud 10 having walls that define an opening, the fan shroud 10 being readable on the frame as recited in the claims of the instant invention; securing bars 20 attached to the inner surfaces of the walls of the fan shroud 10, the securing bars 20 being readable on the flange as recited in the claims of the instant invention; two heat exchangers or coolers 12 and 14 aligned in a side-by-side fashion with each other in the same plane and sealed to one another along a side to form a subassembly mounted in the opening of the frame or fan shroud 10 [see Figures 1 and 2 especially] via securing strip 18, each of the heat exchangers or coolers 12 and 14 having a face, the heat exchangers 12 and 14 being broadly readable on the radiator and the charge air cooler, respectively, as required. There is a seal between the perimeter of the subassembly face and the "flange" 20.

The reference thus reads on the claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Alternately for claims 1 and 9, claims 1, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams ('727, previously of record).

Williams discloses a vehicular cooling package essentially as claimed, including: a radiator 44 and a charge air cooler 60, wherein one side of the radiator 44 is connected to one side of the charge air cooler 60 to form a subassembly [see Figure 3] and a seal, each of the radiator 44 and the charge air

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cooler 60 having a face, the face of the radiator 44 and face of the charge air cooler being aligned with each other (i.e., parallel to each other).

Nevertheless, while Williams does show the faces of the radiator and the charge air cooler as being aligned with each other, Williams does not disclose these faces as being aligned with each other in substantially the same plane as now recited in base claim 1. However, rearranging parts is per se generally not considered inventive, and aligning the faces of the radiator and the charge air cooler with each other in the same plane would, for example, make cleaning the joint face area easier. For example, if a hose were used to flush the front faces of the two heat exchangers as shown in Figure 3 of Williams, debris would collect at the "step" between the two and would necessitate additional flushing, whereas if the faces were aligned with each other in the same plane, the debris would more be more readily washed off.

Also, while Williams does not necessarily disclose the radiator 40 and the charge air cooler 60 as being made of metal and as thus forming a metal-to-metal seal therebetween, Official Notice is hereby taken that it is notoriously well-known in the heat exchanger art to make heat exchangers and heat exchanger parts from heat conductive metals because metals are heat conductive and easy to work.

Thus, it would have been obvious to one skilled in the art at the time of invention to modify the vehicular cooling package of Williams by aligning the faces of the radiator and the charge air cooler in the same plane in order to facilitate cleaning and maintenance of the same, for example.

Thus, it also would have been obvious to one skilled in the art at the time of invention to further modify the vehicular cooling package of Williams by making the radiator and the charge air cooler 60 from selected metallic materials in order to enhance the heat transfer rate therethrough due to the generally higher relative thermal conductivity of metals; if the charge air cooler 60 and the radiator 44 were made from metals, then the seal formed between them would be a metal-to-metal seal as recited in claim 10 of the instant application.

*Allowable Subject Matter*

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Claims 5, 8, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mason discloses a framed charge air cooler arrangement.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

March 6, 2004

  
LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753